

REMARKS

To further the prosecution of the Request For Continued Examination (RCE) filed on April 16, 2003, Applicant has now cancelled a number of claims and has consolidated other of the claims in order to make a more responsive combination of elements which operate to provide the useful functions of Applicant's invention.

Applicant's claims involve a combination of elements wherein Applicant feels this presents an unusual configuration which provides a number of efficient features. Additionally, Applicant feels that the Examiner is using hindsight developed from his cited references in order to recreate Applicant's method and system for downloading SCSI and Servo firmware to SCSI target controllers. It is to be noted, while each of the cited references may possibly cite one or two elements of Applicant's combination, however, there is nothing to indicate or show that in each of the cited references, there is any suggestion or motivation that that particular reference should be combined with some other type of reference.

Thus, Applicant's combination provides an overall set of features which can provide for the most efficient downloading of software to a target controller or servo.

The new claims 16 and 17 indicate the methodical operations of a utility program to download firmware updates in a very efficient manner. This has been described as a DFAST utility program, which has features providing for the integrity of the download, and also involves the selection of a single or double software developed two-dimensional buffer array.

No such teaching has been developed by the cited references. It should also be noted that Applicant's focus is on the software implementation of these various methodical steps, rather than the hardware factors such as are shown in the cited references.

As previously mentioned, not one of the cited references has any suggestion, intimation, or other statement indicating that the features of the other references could or should be combined with the original reference. This requirement was indicated in some of the Federal Circuit Courts' decisions on the question of combining references to show obviousness.

In the case of Monarch Knitting Machinery Corp. v. Sulzer, Morat GNDH, shown at 45 USPQ2d, p.1978, decided March 10, 1998 by the United States Court of Appeals, Federal Circuit, the consideration regarding the combining of references to show obviousness was discussed as follows:

Although "trend" may constitute suggestion or teaching to one of ordinary skill in art and make "minor" changes from prior art in accordance with that trend in order to produce the claimed invention, existence of trend depends on content of prior art and trial court may not proceed to find trend without determining whether prior art contains suggestion or motivation to combine references to form such a trend. (Underlines added).

It may again be indicated that there is no suggestion, intimation, or reason for motivating someone to take the Maebayashi reference and then search around for other elements to be incorporated into it.

Another Court-developed statement regarding the combination of references will be seen in the case of WNS Gaming, Inc. v. International Gaming Technology, decided July 20, 1999, by the U.S. Court of Appeals, Federal Circuit. The Court stated:

Federal District Court did not clearly err in finding that invention of patent for a virtual reel slot machine would not have been obvious in light of three prior references in combination, since, accepting District Court's finding that prior art machines merely simulate physical reels of stated mechanical slot machine, it was not clear error for Court to conclude that these machines do not teach non-uniform mapping of numbers to stop positions on machines' reels in order to decrease odds of winning, as claimed in patent, since there is nothing in those references that indicates motivation to combine their teachings with those of third reference that teaches every aspect of claimed invention except non-uniform mapping of numbers in stop positions, and since infringement plaintiff presented objective evidence of non-obviousness in form of commercial success and long usage. (Underlines added).

Applicant would again emphasize that Applicant's invention is a software-implemented functionality and not a concatenation of hardware modules as it was utilized in the cited references.

Further, as seen in the newly-added claims 16 and 17, there is shown a very efficient system, whereby according to the number of bytes to be downloaded, a choice is made to use a single buffer array, or a first and second buffer array in order

to expedite the downloading of the firmware. This feature operates very effectively time-wise and integrity-wise in a fashion that is very desirable for the users.

Applicant has combined a number of the claims in order to make a more comprehensive set of features which define an overall combination of a method and system for the downloading of firmware to SCSI devices. It would be quite an engineering development and research operation for some engineering group to try to take the technology of the cited references and combine them in order to accomplish what has been accomplished by Applicant's invention.

It is now respectfully requested that Examiner view this useful combination and a whole in its entirety and understand its efficient accomplishment, rather than viewing it as a set of non-related patented technology which could be combined after considerable engineering re-design.

In this regard, it is now respectfully requested that Examiner view the remaining extant claims and the new claims in good light and subsequently provide a timely Notice of Allowance therefor.

Respectfully submitted,

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Patti S. Preddy

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